

### **REMARKS/ARGUMENTS**

Applicants affirm the election of claims of Group I and have canceled and/or labeled claims not within that group accordingly. Independent claims 1 and 27 have been amended to be limited to claims covering compounds of formula (I) only and libraries containing them. However, Applicants note as stated in the Office Action the possibility of rejoinder of method of use claims currently restricted out.

Applicants note with appreciation the examiner's comments about the designation of compounds in Table 1. Applicants clarify that the compound elected is compound 3 shown in the process of paragraph 768, compound 3, in which  $X_1$  is -CH- and the other moieties are as indicated in the Election. Table 1 was meant to be a table of compounds in all of which  $X_1$  is -CH-.

The examiner takes the position that while claims to the elected species are allowable, the claims should be restricted to such species. Applicants respectfully disagree. Applicants are entitled to generic claims, as further discussed below, and request that now that the examiner has indicated the elected species is patentable, examination proceed under MPEP 803.02 to the remainder of the generic claim. The election of species, as stated in that document, was purely provisional, and Applicants are not required to limit their claims to the elected species.

Claim 7 stands rejected for lack of antecedent for phenethyl for group  $R_1$  in claim 1.

Phenethyl is defined by  $R_1$  when  $R_1$  is  $R_6-X_2-C(R_8)(R_8)-R_7$ ,  $R_6$  is aryl, namely phenyl,  $X_2$  is a direct bond, both groups  $R_8$  are H and  $R_7$  is -CH<sub>2</sub>- (a C<sub>1</sub> alkyl group).

Claim 8 stands rejected for lack of antecedent for  $R_1$  being 2-hydroxyethyl.  $R_1$  is 2-hydroxyethyl when  $R_1$  is  $R_6-X_2-C(R_8)(R_8)-R_7$ ,  $R_6$  is Y, Y is hydroxymethyl,  $X_2$  is a direct bond, both groups  $R_8$  are hydrogen and  $R_7$  is a direct bond.

Claim 9 stands rejected for lack of antecedent basis for  $R_2$  being n-butyl, phenyl or n-butyrylamido.

$R_2$  is n-butyl when  $R_2$  is  $R_6-X_2-C(R_8)(R_8)-R_7$ ,  $R_6$  is hydrogen,  $X_2$  is a direct bond, both  $R_8$  groups are hydrogen and  $R_7$  is a C<sub>3</sub> alkyl group. The definition of  $R_2$  as n-butyrylamido is in error; as shown in Table 1, the correct term is 1-hydroxy-n-butyrylamido (Table 1, compounds

3 and 5) and is met when  $R_2$  is  $R_6-X_2-C(R_8)(R_8)-R_7-$ ,  $R_6$  Y, Y is  $CONR_3R_4$ ,  $R_3$  and  $R_4$  are both hydrogen,  $X_2$  is  $C_3H_7$ , one  $R_8$  is hydrogen and the other is hydroxyl, and  $R_7$  is a direct bond. A review of the claim structure showed that  $R_2$  being phenyl was in fact not included; accordingly by this amendment the definition of  $R_2$  has been adjusted, as per claim 10, to include phenyl when  $m'$  is zero.

Applicants note that the accompanying Information Disclosure Statement includes some publications describing compounds within the scope of the current claims. However, these are publications naming various combinations of inventors according to the specific information contain in each publication, as is customary in this field, and all are within one year of the filing date of the priority application in this case, so that they do not constitute statutory bars under 35 U.S.C. 102(b).

### CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

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